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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/526,132 | 02/28/2005 | Terrence E Hogan | P02039US2A | 2691 |

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| EXAMINER | |
|---|---|
| RABAGO, ROBERTO | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

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|---|---|
| 02/25/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/526,132 | HOGAN ET AL. | |
| | Examiner | Art Unit | |
| | Roberto Rábago | 1796 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2,8,12 and 14* is/are allowed.

6)☒ Claim(s) *1,3,4,6,7,9,10,13 and 15* is/are rejected.

7)☒ Claim(s) *5 and 11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. Prior rejections under 325 USC 112 are withdrawn in view of amendment.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 11/30/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Pat. 7,153,919 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The provisional nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 11-13 of 11/607,690, now issued as Patent 7,319,123, is withdrawn in view of: (a) the terminal disclaimer filed in this application over Pat. 7,153,919, and (b) the terminal disclaimer filed in 11/607,690 (now Patent 7,319,123) over Pat. 7,153,919. The three applications/patents are now linked by terminal disclaimer, and since the '123 patent is enforceable only while in common ownership with the '919 patent, no additional disclaimer over the '123 patent is required in this application.

### *Information Disclosure Statement*

3. Applicants have noted in their remarks that two references cited on a prior IDS included incorrect citations. Discussion of patent number errors in applicants' remarks is not an information disclosure statement. If applicants desire the noted references to

be considered on this record, then they should file correct and complete citations on a proper form 1449 or reasonable facsimile thereof so that the examiner may initial and verify that applicants' cited references have been considered.

### *Claim Rejections - 35 USC § 112*

4. Claims 4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 4 and 10 use the phrase "can be defined by" preceding each of the two drawn structures, and the claims are indefinite because "can be defined by" is not sufficiently definitive to determine whether the claim is required to include the drawn structure. Compare claims 1-3, each of which uses the phrase "is defined by" preceding the chemical structures.

5. Claims 1, 6 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 13-31 of each individually of 11/900,664 and 11/900,686.

Each set of cited copending claims differs, each from the other, in the definition of X; however, for the purposes of subject matter cited in this rejection, both cited sets of copending claims are directed to the same content. The instant claims are obvious over the copending claims because one of ordinary skill in the art would select the claimed functional polymer comprising a terminal thiazoline group because such

species have been recommended in claims 4, 15, 25 and 26 of each set of copending claims. Regarding claim 6, official notice is taken that from the claimed "tire component" and “tire" of the copending claims, one of ordinary skill in the art would be motivated to select tire polymers having conventional Tg, including a value within the range claimed in instant claim 6.

Applicant's discussion of the applied applications in the response filed 11/30/2007 has been fully considered but is not persuasive. Applicants argue that no terminal disclaimer is required because the cited applications are continuations of US 7,153,919, over which a terminal disclaimer has already been filed. However, the relationship identified by applicants is not irrelevant to whether or not a disclaimer is required over each document; furthermore, the applied applications and the ‘919 patent are not currently linked by terminal disclaimer. Applicants' apparent implication, that a single disclaimer would cover an entire family of patents and applications with claims in conflict with the instant application, is baseless. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed.

Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. Claims 1, 4, 6 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 15, 16, 18 and 22 of copending Application No. 11/331,663 for the reasons set forth in item 8 of the Office action mailed 7/27/2007.

Applicant's arguments filed 11/30/2007 have been fully considered but they are not persuasive. Applicants again argue that no terminal disclaimer is necessary because extension of monopoly is not being sought. However, as discussed above, unjustified timewise extension is not the only basis for the policy supporting nonstatutory double patenting rejection. Applicants further imply that a two-way test of obviousness is required; however, since no administrative delay has been shown, only a one-way test is required, and therefore the narrower features of the copending claims are irrelevant to this rejection. Since applicants have not traversed the holding that the instant claims are obvious over the copending claims, the rejection is maintained.

7. Claims 1, 3, 4, 6, 7, 9, 10, 13 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-68 of Patent 7,186,845.

Patented claims 23, 36, 39, 40, 44, 46, 49, and 63-66 recite a functionalized polymer, vulcanizable rubber including filler, and tire comprising a polymer reacted with component Q-A-B wherein Q adds to the unsaturated resin, A is a linking group, and B may be thiazoline, and therefore the patented claims anticipate instant claims 1, 3, 4, 7, 9, 10, and 15. One of ordinary skill in the art would be motivated to select a tire rubber with the Tg of claims 6 and 13 because such values are conventional for tire rubbers.

### *Claim Rejections - 35 USC § 102*

8. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Okuhira et al. (US 2002/0183461).

The reference shows a polymer terminated with thiirane at [0137]-[0138].

9. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kapuscinski et al et al. (US 5,374,364).

The reference shows a polymer terminated with thiazoline at col. 3, lines 35-40, and in Examples 1 and 2.

### *Conclusion*

10. Claims 2, 8, 12 and 14 are allowed.

11. Claims 5 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
February 18, 2008